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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Dayton, Ohio

Docket No. **8184.00**

Application of

JAN 04 2006

John G. Savage et al.

Serial No. **09/433,139**

Group Art Unit: **2153**

Filed: **November 3, 1999**

Examiner: **Kimberly D. Flynn**

For: **DIGITAL DATA INTERCHANGE DEVICES AND NETWORKS**

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria VA 22313-1450 on **JAN 04 2006** (Date of Deposit).

Shirley Doll
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

This Appeal Brief is in furtherance of the Notice of Appeal filed in this case on **October 5, 2005**. Three copies of the Appeal Brief are filed herewith. Authorization is given to charge deposit account number 14-0225 for the fee under 37 C.F.R. 1.17 for filing the Appeal Brief.

(1) REAL PARTY IN INTEREST

The present application is assigned to NCR Corporation of Maryland.

(2) RELATED APPEALS AND INTERFERENCES

None.

(3) STATUS OF CLAIMS

The above-identified patent application was filed on November 3, 1999 with claims 1-14. In response to an Office Action mailed on August 12, 2002, claims 6, 7, and 9-14 were canceled and new claims 15-21 were added. In response to a final Office Action mailed on January 15, 2003, an RCE was filed in which claims 1-5, 8, and 15-21 were canceled and claims 22-30 were added. In response to an Office Action mailed on April 10, 2003, no claims were canceled, amended, or added. In response to an Office Action mailed on July 30, 2003, claims 22-30 were canceled and new claims 31-35 were added. In response to a final Office Action mailed on December 18, 2003, an RCE was filed in which claims 31-35 were canceled and claims 36-40 were added. In response to an Office Action mailed on May 24, 2004, claims 36-40 were amended. In response to an Office Action mailed on October 7, 2004, no claims were canceled, amended, or added. In response to a final Office Action mailed on May 5, 2005, no claims were canceled, amended, or added. In response to an Advisory Action mailed on August 5, 2005, a Notice of Appeal was filed on October 5, 2005. Thus, claims 36-40 stand rejected.

Claims 36-40 are being appealed and are attached as an appendix to this Appeal Brief.

(4) STATUS OF AMENDMENTS

No amendments were filed subsequent to the last final rejection.

(5) SUMMARY OF CLAIMED SUBJECT MATTER**Independent Claim 36**

A method is provided of operating an automated teller machine (ATM) 12a when an ATM customer uses a portable device 20 retained by the ATM customer to conduct an ATM cash dispense transaction to obtain cash (see page 5, lines 22-25; page 6, lines 13-16). The method comprises establishing wireless communication with the portable device retained by the ATM customer (see page 6, line 21 to page 7, line 2), executing the ATM cash dispense

transaction (see page 8, lines 22-24), dispensing cash to the ATM customer when the ATM cash dispense transaction is executed (see page 8, lines 22-24), preparing data relating to the ATM cash dispense transaction that has been executed (see page 8, lines 22-26), transferring the prepared data to the portable device retained by the ATM customer via the wireless communication to provide the ATM customer with an electronic receipt for the ATM cash dispense transaction (see page 8, lines 26-28), receiving from the portable device retained by the ATM customer personal information which is unrelated to the ATM cash dispense transaction and which is associated with the ATM customer when the electronic receipt is provided to the ATM customer (see page 9, lines 7-12; page 4, lines 1-14), and downloading to the portable device retained by the ATM customer specific information which is unrelated to the ATM cash dispense transaction and which is tailored to the ATM customer based upon the received personal information from the portable device retained by the ATM customer (see page 9, lines 12-18).

Independent Claim 38

A method is provided of operating an automated teller machine (ATM) 12a when an ATM customer uses a portable device 20 retained by the ATM customer to conduct an ATM cash dispense transaction to obtain cash (see page 5, lines 22-25; page 6, lines 13-16). The method comprises establishing wireless communication with the portable device retained by the ATM customer (see page 6, line 21 to page 7, line 2), executing the ATM cash dispense transaction (see page 8, lines 22-24), dispensing cash to the ATM customer when the ATM cash dispense transaction is executed (see page 8, lines 22-24), preparing data relating to the ATM cash dispense transaction that has been executed (see page 8, lines 22-26), transferring the prepared data to the portable device retained by the ATM customer via the wireless communication to provide the ATM customer with an electronic receipt for the ATM cash dispense transaction (see page 8, lines 26-28), receiving schedule information from a calendar program executing on the portable device retained by the ATM customer (see page 9, lines 7-12; page 4, lines 4-5), and downloading to the portable device retained by the ATM customer specific information which is unrelated to the ATM cash dispense transaction and which is

tailored to the ATM customer based upon the received schedule information (see page 9, lines 12-18).

Independent Claim 40

A method is provided of operating an automated teller machine (ATM) 12a when an ATM customer uses a portable device 20 retained by the ATM customer to conduct an ATM cash dispense transaction to obtain cash (see page 5, lines 22-25; page 6, lines 13-16). The method comprises establishing wireless communication with the portable device retained by the ATM customer (see page 6, line 21 to page 7, line 2), preparing data relating to the ATM cash dispense transaction that has been executed (see page 8, lines 22-26), transferring the prepared data to the portable device retained by the ATM customer via the wireless communication to provide the ATM customer with an electronic receipt for the ATM cash dispense transaction (see page 8, lines 26-28), receiving from the portable device retained by the ATM customer recent purchase information (see page 9, lines 7-12; page 4, lines 4-5), and downloading to the portable device retained by the ATM customer specific information which is unrelated to the ATM cash dispense transaction and which is tailored to the ATM customer based upon the recent purchase information received from the portable device retained by the ATM customer (see page 9, lines 12-18).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

An issue presented for review is whether each of claims 36-40 is patentable under 35 U.S.C. Section 103(a) over U.S. Patent No. 6,334,109 to Kanevsky et al. (referred to herein as “Kanevsky”) in view of U.S. Patent No. 6,431,439 to Suer et al. (referred to herein as “Suer”).

(7) ARGUMENT

Claims 36-40

In the Advisory Action of August 5, 2005, the Examiner states the following:

“Given the teaching of Suer et al. (USPN 6,431,439), a person having ordinary skill *[sic]* in the art would have readily recognized the desirability and advantages of modifying Kanevsky by employing the provision of personalized information to the user of an ATM and a portable device. This benefits the system because the user of an ATM May *[sic]* be in need of information relating to the area of the machine. Further, the system will address a larger number of users by branching out to ATMS in addition to other points of sale while the user may save the information to the portable device. Examiner maintains that there is sufficient motivation to combine the two references.”

Applicant would like to respectfully point out that the rejection of claims 36-40 of the present application under 35 U.S.C. Section 103(a) made in the Office Action is improper for reasons explained hereinbelow.

Kanevsky discloses a system, method, and memory media in which personal advertisement is printed on a sales receipt *[emphasis of underlined italics added by Applicant]*. In fact, this is a claimed feature in Kanevsky (see at least claims 23, 28, and 33 of Kanevsky).

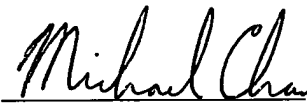
Suer teaches using a portable device to conduct paperless financial transactions (see column 5, lines 15-25 and column 12, lines 42-48 of Suer) *[emphasis of underlined italics added by Applicant]*. Accordingly, Applicant submits that there would be no motivation to modify Kanevsky in view of the teachings of Suer, as suggested by the Examiner in the Office Action. If Kanevsky were modified in view of Suer, a feature claimed by the invention of Kanevsky (i.e., the printing of personal advertisement on a sales receipt) would be destroyed since modified Kanevsky would result in paperless financial transactions. Since a claimed feature of the invention of Kanevsky would be destroyed if Kanevsky were to be modified in view of Suer, there cannot be any motivation to make such a modification.

Applicant has respectfully requested that the Examiner explain why one skilled in the art would modify Kanevsky in view of Suer when the disclosure of Kanevsky and the disclosure of Suer clearly teach away from making such a modification. However, the Examiner has provided no explanation. Accordingly, it is respectfully submitted that the rejection of claims 36-40 of the present application is improper and, therefore, should be withdrawn.

Conclusion

In view of the forgoing reasons, it is clear that the rejection of claims 36-40 under 35 U.S.C. Section 103(a) is improper and, therefore, should be withdrawn. It is respectfully requested that the Board reverse the rejection of claims 36-40.

Respectfully submitted,



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(8) CLAIMS APPENDIX

36. (previously presented): A method of operating an automated teller machine (ATM) when an ATM customer uses a portable device retained by the ATM customer to conduct an ATM cash dispense transaction to obtain cash, the method comprising:

establishing wireless communication with the portable device retained by the ATM customer;

executing the ATM cash dispense transaction;

dispensing cash to the ATM customer when the ATM cash dispense transaction is executed;

preparing data relating to the ATM cash dispense transaction that has been executed;

transferring the prepared data to the portable device retained by the ATM customer via the wireless communication to provide the ATM customer with an electronic receipt for the ATM cash dispense transaction;

receiving from the portable device retained by the ATM customer personal information which is unrelated to the ATM cash dispense transaction and which is associated with the ATM customer when the electronic receipt is provided to the ATM customer; and

downloading to the portable device retained by the ATM customer specific information which is unrelated to the ATM cash dispense transaction and which is tailored to the ATM customer based upon the received personal information from the portable device retained by the ATM customer.

37. (previously presented): A method according to claim 36, further comprising:
analyzing the personal information uploaded from the portable device retained by the ATM customer; and

storing the analyzed information in a database entry as a customer profile.

38. (previously presented): A method of operating an automated teller machine (ATM) when an ATM customer uses a portable device retained by the ATM customer to conduct an ATM cash dispense transaction to obtain cash, the method comprising:

- establishing wireless communication with the portable device retained by the ATM customer;
- executing the ATM cash dispense transaction;
- dispensing cash to the ATM customer when the ATM cash dispense transaction is executed;
- preparing data relating to the ATM cash dispense transaction that has been executed;
- transferring the prepared data to the portable device retained by the ATM customer via the wireless communication to provide the ATM customer with an electronic receipt for the ATM cash dispense transaction;
- receiving schedule information from a calendar program executing on the portable device retained by the ATM customer; and
- downloading to the portable device retained by the ATM customer specific information which is unrelated to the ATM cash dispense transaction and which is tailored to the ATM customer based upon the received schedule information.

39. (previously presented): A method according to claim 38, wherein the specific information downloaded to the portable device retained by the ATM customer relates to events or activities occurring in a location associated with the schedule information.

40. (previously presented): A method of operating an automated teller machine (ATM) when an ATM customer uses a portable device retained by the ATM customer to conduct an ATM cash dispense transaction to obtain cash, the method comprising:

- establishing wireless communication with the portable device retained by the ATM customer;
- preparing data relating to the ATM cash dispense transaction that has been

executed;

transferring the prepared data to the portable device retained by the ATM customer via the wireless communication to provide the ATM customer with an electronic receipt for the ATM cash dispense transaction;

receiving from the portable device retained by the ATM customer recent purchase information; and

downloading to the portable device retained by the ATM customer specific information which is unrelated to the ATM cash dispense transaction and which is tailored to the ATM customer based upon the recent purchase information received from the portable device retained by the ATM customer.

(9) EVIDENCE APPENDIX

None.

(10) RELATED PROCEEDINGS APPENDIX

None.